REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed December 2, 2003. In the Office Action, claims 17-22 were rejected under 35 U.S.C. §101 while claims 16 and 23-33 were rejected under judicially created doctrine of double patenting over prior U.S. Patent No. 6,175,868. In addition, claims 29-33 were rejected under 35 U.S.C. §102(e) as being anticipated by Lewis (U.S. Patent No. 6,421,719) and claims 16, 18-19, 22-26 and 29-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shimony (U.S. Patent No. 5,898,669) in view of Murthy (U.S. Patent No. 6,545,982). Applicants respectfully traverse the rejections in their entirety.

Aside of the arguments to traverse the rejections, Applicants respectfully add the claim of priority to the subject specification, which is consistent with the claim of priority set forth in the filing receipt of the subject application.

A. STATUTORY DOUBLE PATENTING REJECTION

Claims 17-22 were rejected under 35 U.S.C. §101 as allegedly being identical to claims 1-6 of U.S. Patent No. 6,175,868 (hereinafter the "'868 Patent"). Applicants respectfully disagree. Claims 18, 19 and 22 do not include the limitation of a "network configuator," which is set forth in claim 1 of the '868 Patent and included in dependent claims 2, 3 and 6. Moreover, claims 17, 20 and 21 do not include the limitation that the set of monitor program instructions comprises program instructions transferred to the memory through the maintenance data port *from an external network maintenance station* as set forth in claim 1 of the '868 Patent.

In light of the foregoing, Applicants respectfully request withdrawal of the statutory double patenting rejection.

B. NON-STATUTORY DOUBLE PATENTING REJECTION

16 and 23-33 were rejected under judicially created doctrine of double patenting over the '868 Patent. Applicants respectfully requests abeyance of the terminal disclaimer until the pending claims are in condition for allowance. At that time, an executed terminal disclaimer would be provided by Applicants.

C. § 102(E) REJECTION

Claims 29-33 were rejected under 35 U.S.C. §102(e) as being anticipated by Lewis (U.S. Patent No. 6,421,719). Appellants respectfully disagree and submit that the Examiner has not presented a prima facie case of obviousness because Lewis has not been shown to constitute a proper, prior art reference.

The subject application has a filing date of May 15, 1988, which predates the actual filing date of Lewis. Lewis is a Continuation-in-Part (CIP) application with a filing date of September 30, 1998 and claims the benefit of priority on U.S. Application No. 08/855,222 having a filing

date of May 13, 1997 (now U.S. Patent No. 6,209,033). Additional priority is claimed, but it is not pertinent to this discussion.

As the Examiner is aware, a CIP application may claim the benefit of the filing date of the parent application only on subject matter that is disclosed in the parent application. The subject matter added to the CIP application additionally to the subject matter in the parent application may only have the benefit of the filing date of that CIP application, and not the parent application. In fact, in accordance with Manual of Patent Examining Procedure, "[w]hen applicant files a continuation-in-part whose claims are not supported by the parent application, the effective filing date is the filing date of the child CIP." *See M.P.E.P. § 2133.01.* Hence, new matter in a CIP application has the filing date of that CIP application. The earlier filing date of a parent application only pertains to material in the CIP application that is also disclosed in the prior application. *See 35 U.S.C. § 120. See also In re Scheiber*, 587 F.2d 59, 62,199 USPQ 782, 785 (C.C.P.A. 1987).

A CIP application, unlike a continuation application, does not necessarily insure that all critical aspects of the later disclosure were present in the parent. Thus, in situation such as this, only an application disclosing the patentable invention before the addition of new matter, which disclosure is carried over into the patent, can be relied upon to give a reference disclosure the benefit of its filing date for the purpose of supporting a § 102(e)/103 rejection. *See In re Wertheim*, 646 F.2d 527, 209 U.S.P.Q. 554 (C.C.P.A. 1981). Since U.S. Patent No. 6,209,033 (U.S. Application No. 08/855,222) does not disclose subject matter referenced to reject Applicants' claimed invention, U.S. Patent No. 6,209,033 does not support May 13, 1997 as the effective filing date of Lewis.

In particular, on page 5, paragraph 7 of the Office Action, the U.S. Patent No. 6,209,033 fails to discloses (1) "a java virtual machine...configured to process the received data at col. 6, lines 34-53," or (2) "a processor and a memory (not shown) in communication with the virtual machine to evaluate the traffic data and to automatically configure the flow of network data" [see col. 10, lines 28-65].

Therefore, Applicants respectfully request the Examiner to withdraw the rejections unless it can be established that each and every limitation set forth in claims 29-33 is taught by U.S. Patent No. 6,209,033, the parent application for Lewis.

D. § 103(A) REJECTION

Claims 16, 18-19, 22-26 and 29-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shimony (U.S. Patent No. 5,898,669) in view of Murthy (U.S. Patent No. 6,545,982). This rejection is respectfully traversed in view of the following arguments.

Applicants respectfully submit that there is no teaching or suggestion within the art to make the combination proposed by the Examiner. Even if the references could be properly combined, which Applicants maintain that they cannot, the resulting combination fails to teach or suggest the invention as set forth in independent claims 16, 23, and 29.

In particular, with respect to independent claim 16, it is alleged that the ATM interface of Shimony includes a network data monitor (i.e., the rate compare circuitry 72). Applicants respectfully disagree because the rate compare circuitry of Shimony does not constitute a network data monitor being "the network data monitor includes a memory and a set of monitor program instructions stored in the memory" and executed by the processor as set forth as claim 16.

With respect to claim 23, neither Shimony and Murthy, alone or in combination, suggest automatically configuring the network switch *if the network data traffic meets the threshold condition by transferring a set of network configuator program instructions to the memory through the maintenance data port*. Emphasis added. The rate feedback circuitry of Shimony is circuitry (i.e. hardware), and thus, the transfer of the network configuator program instructions is not taught or suggested by this combination. Moreover, the mere presence of a "supervisory" port and its alleged use in modifying the operations of the network switching device does not teach or suggest the transfer of *the set of network configuator program instructions* therethrough. Applicants respectfully request the Examiner to provide specific teachings of such transfers in the event that the §103(a) rejection is maintained.

With respect to claim 29, Applicants respectfully submit that the Examiner has not evaluated all of the limitations set forth in this claim, contrary to the holding by the Federal Circuit requiring such evaluation when determining obviousness. *See In re Fine*, 873 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *See also In re Evanega*, 829 F.2d 1110, 4 U.S.P.Q.2d 1249 (Fed. Cir. 1987). Applicants respectfully request the Examiner to reconsider the allowability of the claim in light of the limitations set forth therein.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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